

REMARKS

Applicants request favorable reconsideration of the subject application in view of the preceding amendments and the following remarks.

Introduction

In response to the Office Action dated May 11, 2006 ("Action"), in the subject application, Applicants timely filed a RESPONSE TO NON-FINAL OFFICE ACTION on August 11, 2006 ("Initial Response"), within three months of the Action.

Applicants now respectfully request the Examiner to enter this SUPPLEMENTAL AMENDMENT, which is presented to protect Applicants' right to copy claims under 35 U.S.C. § 135(b), as discussed below.

Claim Status

Claims 41-50, 62-65 and 68-314 are pending in the subject application. Claims 84-314 are newly presented for consideration. Claims 41, 47, 63, 68, 73, 75, 77, 84, 94, 102, 136, 152, 183, 196, 213, 216, 251, 267 and 301 are independent claims.

Applicants' Statement Under 37 C.F.R. §§ 10.23(c)(7) and 41.202(a)(1)

Applicants respectfully submit that Claims 84-101, 196-215, 313 and 314 herein have been copied (some in modified form) from Claims 1, 2, 4-11, 13, 19, 20 and 22-27 of U.S. Patent No. 6,936,071 ("Marnay '071 Patent"), and that Claims 102-195 and 216-312 herein have been copied (some in modified form) from Claims 37-53, 55-67, 75-81, 83, 85-92, 95-114, 116-126, 134-140, 144-149 and 152-155 of U.S. Patent Application No. 10/998,951, as amended on October 18, 2005 ("Marnay '951 Patent Appln."). The correspondence between these claims is shown below in Table I for the Marnay '071 Patent and Table II for the Marnay '951 Patent Appln., as follows:

TABLE I	
Subject Application Claims	Marnay '071 Patent Claims
84, 196-203	1
85, 204	2
86, 205	4
87, 206	5
88, 207	6
89, 208	7
90, 209	8
91, 210	9
92, 211	10
313, 314	11
93, 212	13
94, 213-215	19
95	20
96	22
97	23
98	24
99	25
100	26
101	27

TABLE II	
Subject Application Claims	Marnay '951 Patent Appln. Claims
102, 216, 217	37
103, 218	38
104, 219	39
105, 220	40
106, 221	41
107, 222	42
108, 223	43
109, 224	44
110, 225	45
111, 226	46
112, 227	47
113, 228	48
114, 229	49
115, 230	50
116, 231	51
117, 232	52
118, 233	53
119, 234	55

TABLE II	
Subject Application Claims	Marnay '951 Patent Appln. Claims
120, 235	56
121, 236	57
122, 237	58
123, 238	59
124, 239	60
125, 240	61
126, 241	62
127, 242	63
128, 243	64
129, 244	65
130, 245	66
131, 246	67
132, 247	75
133, 248	76
134, 249	77
135, 250	78
136, 251	79
137, 252, 254	80
138, 253	81
139, 255	83
140, 256	85
141, 257	86
142, 258	87
143, 259	88
144, 260	89
145, 261	90
146, 262	91
147, 263	92
148, 264	95
149, 265	96
150, 266	97
151	98
152, 267-269	99
153, 270	100
154, 271	101
155, 272	102
156, 273	103
157, 274	104
158, 275	105
159, 276	106
160, 277	107

TABLE II	
Subject Application Claims	Marnay '951 Patent Appln. Claims
161, 278	108
162, 279	109
163, 280	110
164, 281	111
165, 282	112
166, 283	113
167, 284	114
168, 285	116
169, 286, 287	117
170, 288	118
171, 289	119
172, 290	120
173, 291	121
174, 292	122
175, 293	123
176, 294	124
177, 295	125
178, 296	126
179, 297	134
180, 298	135
181, 299	136
182, 300	137
183, 301	138
184, 302	139
185, 303	140
186, 304	144
187, 305	145
188, 306	146
189, 307	147
190, 308	148
191, 309	149
192, 310	152
193, 311	153
194, 312	154
195	155

Applicants note that a similar set of copied claims is being concurrently filed in pending U.S. Patent Appln. No. 11/064,185, which is also owned by Applicants' assignee.

Pending Rejections

Turning to the outstanding rejections set forth in the Action:

- (1) Claims 41-50 and 61-80 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-40 of U.S. Patent No. 6,740,118;
- (2) Claims 41-44, 48, 49, 73 and 76 were rejected under 35 U.S.C. § 102(a) as being anticipated by WO 01/01893 to Marnay et al. (“Marnay PCT ‘893”);
- (3) Claims 41-46, 48, 73 and 74 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,592,624 to Fraser et al. (“Fraser ‘624”);
- (4) Claims 41-44, 48-50, 73, 74, 76, 77, 79 and 80 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,113,637 to Gill et al. (“Gill ‘637”) in view of Fraser;
- (5) Claims 61, 62, 64, 66, 67, 69, 70 and 71 were rejected under 35 U.S.C. § 103(a) as being obvious over Fraser in view of U.S. Patent No. 6,743,256 to Mason (“Mason ‘256”);
- (6) Claims 61, 62, 65 and 78 were rejected under 35 U.S.C. § 103(a) as being obvious over Gill ‘637 in view of Fraser ‘624 and further in view of Mason ‘256; and
- (7) Claims 66, 67, 69, 71 and 72 were rejected under 35 U.S.C. § 103(a) as being obvious over Marnay PCT ‘893 in view of Mason ‘256.

Patentability of Newly Presented Claims in View of the Pending Rejections

Applicants submit that new independent Claims 84, 94, 102, 136, 152, 183, 196, 213, 216, 251, 267 and 301 are patentable for at least the following reasons.

Each of new independent Claims 84, 94, 102, 136, 152, 183, 196, 213, 216, 251, 267 and 301 is directed to either an intervertebral implant or a component for an intervertebral

implant, and recites, in part, one or more of the following features: (a) The implant or component therefor comprises a single anchor or a single flange; (b) An anchor or a flange has a height greater than its width; (c) An anchor or a flange is located along a line parallel to a defined path, and lies essentially midway between defined lateral planes; and (d) An anchor or a flange is adapted to enter a groove or a preformed opening in the adjacent vertebrae as the implant moves along the defined path into the intervertebral space. Applicants submit, however, that none of the cited documents, namely Marnay PCT '893, Fraser '624, Gill '637, and Mason '256, whether taken individually or in combination, assuming that the documents could be combined, teaches or suggests at least these salient features of the invention, as variously recited in the context of new independent Claims 84, 94, 102, 136, 152, 183, 196, 213, 216, 251, 267 and 301.

With respect to Marnay PCT '893, this publication discloses plural protrusions, stating, *e.g.*, “The upper part 2 is embodied flat on its top, thus creating a support face 5, on which various kinds of protrusions 6, 7 are disposed which serve the purpose of anchoring the upper part 2 in a vertebra that rests, with its end face toward an intervertebral space, on the support face 5.” (Certified Translation of Marnay PCT EP99/04628 (WO 01/01893) obtained from U.S. Patent Appln. No. 10/018,402 Filewrapper, page 7, lines 18-23 (emphasis added) (*see* IDS filed concurrently herewith).) Similarly, every drawing in Marnay PCT '893 illustrates multiple protrusions—not, for example, a “single anchor” or a “single flange.” (*See* Marnay PCT '893, figs. 1 to 7, items 6, 7 and 14; Certified Translation of Marnay PCT EP99/04628, page 7, lines 12-13.) Also, Marnay PCT '893 does not indicate that the figures are drawn to scale, and is completely silent on the particular proportions and sizes of the “protrusions 6, 7.” (Applicants note that the disclosure of Marnay PCT '893 is not the same as the disclosure in U.S.

Patent No. 6,936,071 to Marnay ("Marnay '071"), even though Marnay '071 recites on its face a relationship with Marnay PCT '893. Specifically, a Supplemental Amendment, dated October 12, 2004, in Marnay '071 added what became approximately 78 lines of continuous text in Marnay '071, and a Preliminary Amendment, including Amendments to the Specification, dated February 25, 2005, added more text at column 5, line 60, and column 6, lines 9-11, 34, 38 and 41-42.)

Lastly, the non-statutory double patenting rejection has been obviated by the Terminal Disclaimer filed on August 11, 2006 in the subject application.

Based on the foregoing, the pending rejections are respectfully traversed.

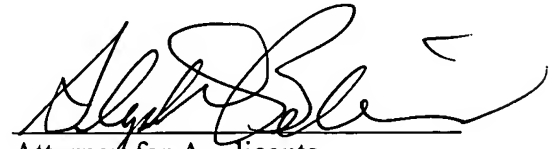
New dependent Claims 85-93, 95-101, 103-135, 137-151, 153-182, 184-195, 197-212, 214, 215, 217-250, 252-266, 268-300 and 302-314 also should be deemed allowable, in their own right, for defining other patentable features of the present invention in addition to those recited in new independent Claims 84, 94, 102, 136, 152, 183, 196, 213, 216, 251, 267 and 301. Further individual consideration of these dependent claims is requested.

Conclusion

Applicants have copied the above-identified claims (some in modified form) from the Marnay '071 Patent and the Marnay '951 Patent Appln. for the purpose of provoking an interference. Specific support for the copied claims and the identification of a proposed count for the interference will be submitted in a separate Request for Interference which will be filed in due course, if the Examiner wishes. In the meantime, if the Examiner has any questions, Applicants respectfully request that the Examiner contact the undersigned before acting on the subject application.

Applicants' undersigned attorney may be reached in our Washington, D.C., office by telephone at (202) 530-1010. All correspondence should continue to be directed to the correspondence address of record.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Stephen E. Belisle', written over a horizontal line.

Attorney for Applicants
Stephen E. Belisle
Registration No. 46,546

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

DC_Main 251755_1